

The Examiner has indicated in the Office action that claims 8-13 and 21-23 are allowed. The Examiner further indicated that claims 2-5 recite allowable subject matter. As previously indicated, claim 2 is rewritten hereby in independent form including all of the limitations of base claim 1 from which it depends. Therefore, applicant respectfully requests the withdrawal of the Examiner's objection to claims 2-5.

Claims 14, 19 and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by Kuhar (U.S. Patent No. 5,482,100), claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhar '100, and claims 1, 6, 7, 15-17 and 24-30 were rejected under §103(a) as being unpatentable over Kuhar '100 in view of Carouso (U.S. Patent No. 1,863,620). Applicant respectfully traverses these rejections.

✓ Regarding the rejections of claims 14, 19 and 20 under §102(b) and claim 18 under §103(a), claim 14 recites a cordless blind including a means for providing resistant force on movement of one of the first and second cords in one direction. Applicant respectfully submits that the means for providing resistant force in one direction recited in claim 14 is neither disclosed nor suggested by the Kuhar '100 patent. Kuhar '100 teaches slots 56 that may be used to increase the tension of the cord 52 traveling through portion 47 toward cord spool 30. Kuhar '100, col. 4, lines 51-54. The slots 56, which are illustrated in Fig. 2 of the Kuhar '100 patent, are stationary and appear to apply a resistant force as the cord 52 is pulled away from the cord spool 30, thereby providing resistant force on the movement of cord 52 in both directions. Further, the Kuhar '100 patent does not suggest that either the slots 56 or any other structure may be used to provide resistant force in one direction. Therefore, because the Kuhar '100 patent cited in the Office action does not disclose or suggest a means for providing resistant force on movement of one of the first and second cords in one direction as recited in claim 14, it follows that the Kuhar '100 patent neither anticipates nor renders obvious independent claim 14 and claims 18-20 depending there from.

Regarding claims 1, 6, 7, 15-17 and 24-30, Applicant respectfully submits that the combination of the Kuhar and Carouso patents proposed by the Examiner does not render the claims obvious because: 1) there is no suggestion or motivation to combine the reference in the manner proposed by the Examiner; 2) the Carouso reference applied by the Examiner is non-analogous art with respect to the claimed invention; and 3) the combination of the references proposed by the examiner involves improper hindsight reconstruction based on Applicant's own disclosure.

In order to establish a prima facie case of obviousness, there must be *actual evidence* of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be *clear and particular*. See, e.g., *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved...

\* \* \*

The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**. Broad conclusory statements regarding the teaching of multiple references, standing alone, are **not 'evidence.'** (emphasis added, citations omitted).

In order to establish a prima facie case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, e.g., *Ecolochem Inc. v. Southern California Edison*, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) and *In re Dembiczak*, 50 U.S.P.Q.2d at 1617-18, where the Court of Appeals for the Federal Circuit stated:

In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. *Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.*

\* \* \*

Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific --or even inferential-- findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

\* \* \*

Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. (emphasis added)

The mere fact that references *can* be modified is *not* sufficient to establish a *prima facie* case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis original). See *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985) (the prior art must make a suggestion of or provide an incentive for the claimed combination of elements in order to establish a *prima facie* case of obviousness).

For rejections of claims based on obviousness under 35 U.S.C. § 103(a), the Federal Circuit has explained the requirements under the Administrative Procedure Act<sup>1</sup> as follows:

When patentability turns on a question of obviousness, the search for and analysis of the prior art includes **evidence** relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

\* \* \* \*

'The factual inquiry whether to combine references must be thorough and searching.' It must be based on *objective evidence* of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.

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<sup>1</sup> Relatively recent Federal Circuit cases have clarified that tribunals of the Patent Office are subject to the Administrative Procedure Act. For example, in *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002), the Federal circuit explained:

The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of 'reasoned decision making.' Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

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Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary *finding* and to provide an administrative record showing the *evidence on which the findings are based*, accompanied by the agency's *reasoning in reaching its conclusions*.

'a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'

\* \* \* \*

The need for specificity pervades this authority. *See, e.g., In re Kotzab, ('particular finding must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed')*

\* \* \* \*

In other words, the Board *must explain the reasons* one of ordinary skill in the art *would have been motivated to select the references and to combine them* to render the claimed invention obvious.

\* \* \* \*

In its decision on Lee's patent application, the Board rejected the need for 'any specific hint or suggestion in a particular reference' to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

*In re Lee*, U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002) (citations omitted, emphasis added). Thus, as should be apparent from the above quotes of the Federal Circuit, to make a prima facie case of obviousness, there must be *evidence* regarding the requisite suggestion or motivation to combine or modify the prior art, and a *particular finding* must be made as to *why* one skilled in the art would have been motivated to make the combination or modification.

In connection with the rejection of claims 1, 6, 7, 15-17 and 24-30, the Office action describes the purported combination of Kuhar '100 and Carouso as follows:

'100 discloses everything except the one-way tensioning system. '100 does not provide a tensioning system in the form of slots 56, column 4, lines 51-54. Carouso discloses a tensioning member to prevent 'creep' of the cords 17 back onto the spools 19, 20. The tensioning pulley 25 is a one-way tensioner, as disclosed from page 1, line 99 to page 2, line 13. In view of this teaching by Carouso, it would have been obvious to modify Kuhar whereby his tensioning system is replaced with the more efficient tensioner of Carouso. Other motivation to combine these references as proposed would simply lie in the fact that the Carouso tensioner is an obvious expedient of the tensioner in Kuhar.

Office action dated July 29, 2002, p. 3.

The Office action merely states in conclusory terms that it would have been obvious to modify Kuhar by replacing the slots 56 with the pulley 25 of Carouso. The cited references provide no motivation or suggestion of the replacement of elements proposed by the Examiner. As discussed above, the slots 56 provide a resistant force on movement of the cords in both directions, and the Kuhar '100 patent offers no suggestion of replacing the slots 56 with any mechanism that provides a resistant force in one direction, or a pulley rotatable in only one direction. Moreover, the Kuhar '100 patent relates to cordless, balanced blinds wherein the spring motor balances the varying weight of the bottom rail and accumulated window covering material as the blinds are raised and lowered. Kuhar '100, col. 1, lines 8-16. As such, the force of the spring motor is at its highest level when the blind is fully raised and the cords support the full weight of the window covering, and at its lowest when the blind is fully lowered and the cords support none of, or a minimal amount of, the window covering. Col. 2, lines 43-50. Therefore, Kuhar '100 provides no suggestion or motivation to look to mechanisms, such as the mechanism of the Carouso patent, wherein a spring is used solely to rewind a cord supporting a relatively constant weight, and wherein the force of the spring increases as the cord is unwound to lower the relatively constant weight.

Similarly, the Carouso patent provides no motivation or suggestion for combining the pulley of the permanent wave apparatus disclosed therein with a cordless, balanced blind as disclosed in the Kuhar '100 patent. As discussed above, Carouso is directed to the use of a pulley to prevent the rewinding of a cord supporting a relatively constant weight against a spring force that increases as the cord is unwound, while the Kuhar '100 patent is directed to balancing the varying force of a spring motor against the varying weight of a bottom rail and accumulated window covering as a window blind is raised and lowered. Carouso does not disclose or suggest that such a pulley would be useful, or even necessary, in a mechanism such as the blind of the Kuhar '100 patent wherein the varying weight of a window covering is **balanced** by the varying spring force of a spring motor.

Despite the lack of suggestion or motivation in the references, the Examiner asserts that the proposed combination is obvious because the Carouso device is "more efficient" and "an obvious expedient of the tensioner in Kuhar." However, there is no teaching or suggestion whatsoever in either reference, and the Examiner cites to no support for the assertion, that the pulley of a permanent wave apparatus is "more efficient" than, or an

"obvious expedient" for, slots providing resistant force in both directions in a cordless, balanced window blind. Because neither the Kuhar '100 patent nor the Carouso patent provide the necessary suggestion or motivation for the combination proposed by the Examiner, it follows that claims 1, 6, 7, 15-17 and 24-30 are not rendered obvious by the proposed combination of the references.

In addition to lacking the necessary suggestion or motivation to combine the cited references, the Carouso patent cannot be relied upon as a basis for rejection because the Carouso patent is non-analogous art with respect to the claimed invention. It is well settled that only pertinent prior art can be utilized in an obviousness rejection:

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be *in the field of applicant's endeavor* or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

*In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). The field of the present invention is clearly defined in the application to be window furnishings. For example, the first two lines of the application state: "The present invention relates to a *window furnishing* ...," and the entire Background of the Invention and Summary of the Invention sections of the application are directed to window furnishings and, in particular, to cordless blinds. Conversely, the subject matter of the Carouso patent is "particularly adapted to use in a chandelier for the support of electric heaters for treatment of the human hair to impart thereto what is commonly known as a permanent wave." Consequently, the Carouso patent is not in the Applicant's field of endeavor.

Nor is the Carouso patent reasonably pertinent to the particular problem with which Applicant was concerned. As discussed above, the Carouso patent is directed to preventing the rewinding of a cord supporting a relatively constant weight against a spring force that increases as the cord is unwound. Conversely, the present application is directed to a cordless balanced blind in which a varying spring force is used to balance a weight that varies based on the amount of window covering accumulated on the bottom rail. Providing a braking force to act against a spring force that increases while the supported weight remains relatively constant, and for which a braking force is always required at all positions to prevent the spring force from re-winding the cord, is not reasonably pertinent to the problem of applying a resistant force in a window blind where the spring force varies proportionately

with a varying weight of the bottom rail and accumulated window covering to balance the window blind. Since the Carouso patent is neither in the field of Applicant's endeavor nor reasonably pertinent to the particular problem with which Applicant was concerned, the use of the Carouso patent as a reference to reject Applicant's claims is improper.

Finally, the combination proposed by the Examiner is based on inappropriate hindsight reconstruction using the Applicant's own disclosure. An applicant's own work cannot be used to provide the motivation or suggestion for the proposed combination of references:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'* Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

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Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability --the essence of hindsight.

*In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 2000) (citations omitted) (emphasis added); see also *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983) ("The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit."). As discussed above, the prior art does not appear to provide the necessary motivation or suggestion to provide a one-way tensioning mechanism or pulley in a cordless blind as recited in the claims of the present invention. The only motivation or suggestion appears to come from Applicant's own disclosure. Therefore, in addition to the lack of suggestion of motivation in the references, and the Carouso patent being non-analogous art, because the

only suggestion or motivation for the combination of elements recited in the claims is the disclosure in the present application, it follows that the proposed combination of the Kuhar '100 and Carouso patents does not render claims 1, 6, 7, 15-17 and 24-30 obvious.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

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December 26, 2002



**ATTACHMENT A - VERSION OF THE AMENDED CLAIM 2**  
**SHOWING CHANGES MADE IN THIS RESPONSE**

2. (Amended) [The cordless blind of Claim 1] A cordless blind comprising:  
a headrail;  
a bottom rail suspended from the headrail by a first cord and a second cord;  
a window covering disposed between the headrail and the bottom rail;  
a drive actuator including:  
a spring motor, and  
a spool for accumulating the cords coupled to the spring motor; and,  
a one-way tensioning mechanism, wherein the tensioning mechanism is configured to  
provide a resistant force on movement of one of the first and second cords in one direction,  
wherein the one-way tensioning mechanism comprises:
- a mechanism bracket, with the mechanism bracket having a base and a first upright and a second upright coupled to the base, with each upright defining an aperture and further, each upright including a pawl, with one pawl aligned in facing relationship with the other pawl and,
- a pulley mounted between the two uprights, with the pulley having a cylinder with a side wall on each end of the cylinder, each sidewall having an inner face and an outer face, with each outer face having a plurality of ratchet teeth configured to selectively engage the pawl on each upright.